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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/062,552	04/20/1998	YOSHINOBU SHIRAIWA	35.G2135	3178
5514	7590	05/13/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WALLERSON, MARK E	
		ART UNIT	PAPER NUMBER	
		2626	DATE MAILED: 05/13/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/062,552

Applicant(s)

SHIRAIWA, YOSHINOBU

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 17 February 2004.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 80-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 80-93 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **Part III DETAILED ACTION**

#### *Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on 2/17/2004.
  2. This application has been reconsidered. Claims 80-93 are pending.
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- #### *Claim Rejections - 35 USC § 112*
3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
  4. Claims 80-87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claims 80, 86 and 87, there is no disclosure in the original specification that "when reproduction is not performed for the particular image, information introducing an existence of the particular image is stored a memory". If Applicant believes that rejection to be erroneous, Applicant is requested to provide specific support for this subject matter in the original specification.
  5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 80-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 80, 86 and 87, the phrase "information introducing an existence of the particular image" is unclear.

Additionally, it is unclear to the Examiner how information pertaining to the existence of an image would be stored in the memory if the image is not recorded in the recording medium.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 80, 81, 82, 83, 84, 85, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (U. S. 6,111,659) in view of Timmermans (U. S. 5,862,297).

With respect to claims 80, 81, 86, and 87 (as best understood by the Examiner), Murata discloses an accessing unit (88) that accesses a recording medium (memory card), the recording medium having a plurality of reproducible images (image data files) and a reproduction instruction file (print job command file) containing plural file names specifying images to be reproduced (figure 6), the instruction file separate from the plural images (column 6, lines 40-46); means for reading the reproduction instruction file (column 8, lines 52-60); means for

controlling reproduction of the images by reading the images specified by the reproduction instruction file (column 8, line 52 to column 9, line 1), and printing a reproducible image specified by the instruction file if the reproducible image is recorded in the recording medium (column 8, line 52 to column 9, line 1).

Murata differs from claims 80, 86, and 87 in that he does not clearly disclose that reproduction is not performed for a particular image if that image is not recorded on the recording medium. However, it would be clearly obvious to one of ordinary skill in the art that if an image is not recorded on a recording medium (a disk), it cannot be read and printed.

Murata also differs from claims 80, 86, and 87 in that he does not clearly disclose that when reproduction is not performed for the particular image, information introducing an existence of the particular image is stored in a memory.

Timmermans discloses a photographic printing system wherein if there is no picture parameter data stored on a disk or the picture parameter data is incorrect, information about the desired changes of the picture parameter data relative to the set of picture parameter data recorded on the record carrier is stored for the record carrier specified by means of the record carrier identification code (column 10, lines 36-56) (which reads on storing information pertaining to the existence of a particular image), wherein the format of the picture parameter data included a DID in which the unique record carrier identification code is stored (column 10, line 57 to column 11, line 23). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata so that when reproduction is not performed for the particular image, information introducing an existence of the particular image is stored in a memory. It would have been obvious to one of ordinary skill in the art at the time

of the invention to have modified Murata by the teaching of Timmermans in order to improve the image processing.

With regard to claims 83, 84, and 85, Murata discloses means for displaying the file name of the image to be reproduced and the image to be reproduced (column 7, line 60 to column 8, line 51).

With respect to claim 82, Timmermans discloses displaying information relating to the image not reproduced (column 10, lines 36-56).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 88-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata in view of Haneda (U. S. 6,243,171).

With respect to claims 88, 90, 92 and 93, Murata discloses a recording control apparatus for controlling recording of images in a recording medium (memory card), the apparatus including an accessing unit (88) that accesses a recording medium for storing a plurality of reproducible images and a reproduction instruction file (column 6, lines 40-46) containing instruction information including plural file names (figure 6) specifying image data to be reproduced (print control data) (column 6, lines 40-46), comprising an indication section for indicating deletion of at least one of the images whether the indicated image is instructed to be reproduced or not (which reads on erasing the image data file stored in the memory card)

(column 3, lines 36-44 and column 9, lines 1-4), and a control section for controlling deletion of the instruction information in the instruction file corresponding to the indicated image (column 3, lines 36-44).

Murata differs from claims 88, 92, and 93 in that he does not clearly disclose that the accessing unit accesses the recording medium (accessed to specify an image to be reproduced) in accordance with a manual operation.

Haneda discloses a laboratory system wherein image data and order data recorded on a recording medium can be manually accessed by an operator in the laboratory (column 5, lines 30-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata wherein the accessing unit accesses the recording medium in accordance with a manual operation. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata by the teaching of Haneda in order to obtain more user control.

With regard to claim 89, Murata discloses the recording medium is a detachable memory (column 3, lines 45-50).

With respect to claim 91, Murata discloses a display unit to display the image to be deleted (figure 16).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E Wallerson  
Primary Examiner  
Art Unit 2626